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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/917,725	07/31/2001	Eduardo Gomez Canon	023693-00001	1249
4372 7590 12/19/2006 ARENT FOX PLLC 1050 CONNECTICUT AVENUE, N.W. SUITE 400 WASHINGTON, DC 20036			EXAMINER CHARLES, DEBRA F	
			ART UNIT	PAPER NUMBER
			3691	
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		12/19/2006	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

09/917,725

Applicant(s)

CANON, EDUARDO GOMEZ

Examiner

Debra F. Charles

Art Unit

3691

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 May 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

This is a supplementary action in response to the attorney's request that the office action address the amended wording of the claims.

Response to Amendment

1. Claim 2 has been canceled. Claims 11, 12, 13, 14, 15, 16, 17, and 18 has been amended to read "nonfinancial". Claim 26 was added in.

Response to Arguments

1. The attorney's argument is that the amendment to the claims has not been acknowledged and treated in the examination of the claims. The examiner added another reference to completely deal with the amendment to the claims.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 1, 3-26 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since

the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. See MPEP § 2173.05(c). Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claim 1 recites the broad recitation independent transaction types, and the claim also recites medical transaction, financial transaction and e-commerce transaction which is the narrower statement of the range/limitation. Also, claim 11 indicates the broad statement "plurality of transaction types" and then the narrow limitation of "executing a first nonfinancial transaction type".

Claim Objections

3. Claims 3, 5, and 6, are objected to because of the following informalities: claims are dependent on a cancelled claim 2. Appropriate correction is required.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1,3-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Buell(US 5816620 A) and Yaker(EPO Pub 0683465 A2).

As per claims 1, 3-6: Buell disclose a card substrate with microchip and magnetic medium(Abstract, col. 3,lines 40-60, col. 4, lines 40-65).

Buell fails to teach executing a plurality of independent transaction types being coordinated through a plurality of vendors of service and products, wherein said plurality of transaction types includes a medical transaction, a financial transaction, and an e-commerce transaction. However, Yaker does teach patient health care card that that has nonfinancial information and also financial information(entire document). Therefore, it would have been obvious to one of ordinary skill in the art the time the Applicant's invention was made to modify the teachings of Buell to include the step of Yaker. The motivation to combine these references is to use the same card for a plurality of transaction types.

6. Claims 7, 8, 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Buell(US 5816620 A) and Yaker(EPO Pub 0683465 A2) as per claim 1 above and in view of Sehr(US 5566327 A).

Both Buell and Yaker fail to teach picture on card, security information and digital signature. However, Sehr teaches placed in the vicinity of, the smart card reader. The biometrics box 12 allows the PC to capture the biometrics characteristics, such a fingerprints, voice, digital signature, picture or retina of a particular cardholder, so that the system can compare this biometrics data with the one stored in the databases or guest card. The PC-machine 14, which is shown as a point-of-service station for the control center 1, represents any number of such stations that can be stand alone stations or configured as client-server networks, or an integral part of mainframe-based MIS (Management Information Systems) computer platforms that are located at the theme park's premises. The PC-monitor 15, or any other computer terminal screen, represents the media for displaying any data, including text and graphics, onto the PC-screen. The link 23 between the centers and databases per se, as well as the link 16 between the local systems components, can be implemented by any commercial available

wire-based or wireless communications technology, including telephone and modem equipment(col. 4, line 5-col. 5, line 45). Therefore, it would have been obvious to one of ordinary skill in the art the time the Applicant's invention was made to modify the teachings of Buell and Yaker to include the step of Sehr. The motivation to combine these references is to use the same card for a plurality of transaction types.

7. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Buell and Yaker as applied to claim 1 above, and further in view of "Shoppers No Longer Loyal" Birmingham Post, June 11, 1998, page 3.

Buell and Yaker fail to teach microchip bonus rewards based on transactions. However, "Shoppers No Longer Loyal" Birmingham Post, June 11, 1998, page 3 does teach introduction of smart cards which were able to store points on microchips. Therefore, it would have been obvious to one of ordinary skill in the art the time the Applicant's invention was made to modify the teachings of Buell and Yaker to include the step of "Shoppers No Longer Loyal" Birmingham Post, June 11, 1998, page 3. The motivation to combine these references is to store the points accrued on the storage space in the chipcard.

Claims 11, 12, 13, 14, 19,20, 21, and 23 are rejected under 35 U.S.C.

103(a) as being unpatentable over Yaker(EPO Pub 0683465 A2).

Claim 11: Yaker does teach the transaction features, including 3 transactions and inputting an authenticating code(entire document especially col. 3, lines 45-55, Fig. 1). Yaker does not explicitly disclose receiving confirmation of desired third transaction type. However, Yaker does show terminal. Thus, it would have been obvious to one with an ordinary level of skill in the art to employ a display on the terminal since many terminals do have displays to get the benefit of receiving a confirmation that the transaction has occurred or is completed.

8. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Yaker as applied to claim 11 above, and further in view of Buell and Urquhart et al.(US 6129275 A).

Yaker fail to teach having updated information of said nonfinancial transaction type. However, Buell does teach nonfinancial data on smart card(Abstract, col. 3, line 40-col. 4, all). Therefore, it would have been obvious to one of ordinary skill in the art the time the Applicant's invention was made to modify the teachings of Buell to include the step of Yaker. The motivation to combine these references is to place nonfinancial data on the smart card.

Both Buell and Yaker fail to teach obtaining smart card from said first card processing unit. However, Urquhart et al. does teach dispensing a smart card from a vending machine. Therefore, it would have been obvious to one of ordinary skill in the art the time the Applicant's invention was made to modify the teachings of Buell and Yaker to include the step of Urquhart et al. The motivation to combine these references is obtaining a smart card from a card processing unit.

9. Claims 16-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yaker, Buell and Urquhart as applied to claim 14 above, and further in view of "Axolotl Unveils Private Patient Portal", PR Newswire, New York, April 10, 2000, pg. 1.

Yaker, Buell and Urquhart fail to teach internet portal used to schedule appointments. However, "Axolotl Unveils Private Patient Portal", PR Newswire, New York, April 10, 2000, pg. 1 does teach using internet portal to schedule appointment(whole document). Therefore, it would have been obvious to one of ordinary skill in the art the time the Applicant's invention was made to modify the teachings of Yaker, Buell and Urquhart to include the step of "Axolotl Unveils Private Patient Portal", PR Newswire, New York, April 10, 2000, pg. 1. The motivation to combine these references is to facilitate scheduling appointments.

10. Claims 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Yaker as applied to claim 19, 23 above, and further in view of Drummond et al. (2001/0014881A1).

Yaker fail to teach inserting said smart card in an opening of an Automatic Teller Machine (ATM), inputting a Personal Identification Number from an input unit of said ATM, selecting said desired second transaction type from a plurality of second transaction types, commencing said desired financial transaction type, and retrieving said smart card from said ATM. However, Drummond et al. discloses the steps of executing said second transaction type further comprises the steps of: inserting said smart card in an opening

of an Automatic Teller Machine (ATM), inputting a Personal Identification Number from an input unit of said ATM(para 0143, 0144),selecting said desired second transaction type from a plurality of second transaction types, commencing said desired financial transaction type, and retrieving said smart card from said ATM(para 0142, 0143, claim 1, 6,7,8,30). Therefore, it would have been obvious to one of ordinary skill in the art the time the Applicant's invention was made to modify the teachings of Yaker to include the step of Drummond et al. The motivation to combine these references is to facilitate ATM usage.

Re claims 24 and 25. Yaker fail to teach steps of executing said third transaction type further comprises the step of:

transmitting said information of said third transaction type and said authenticating code to a server configured on the Internet or the WWW.

And formulating said desired third transaction type wherein said desired third transaction type is to purchase a consumer product or service through the Internet or WWW. However, Drummond et al. discloses the steps of executing said third transaction type further comprises the step of:

transmitting said information of said third transaction type and said authenticating code to a server configured on the Internet or the WWW. And formulating said desired third transaction type wherein said desired third transaction type is to purchase a consumer product or service through the Internet or WWW(para 0162, 0163, 0197). Therefore, it would have been obvious to one of ordinary skill in the art the time the Applicant's invention was made to modify the teachings of Yaker to include the step of Drummond et al. The motivation to combine these references is to facilitate ATM/internet/WWW usage to purchase goods.

11. Claim 26 is rejected under 35 U.S.C. 103(a) as being unpatentable over Drummond et al. as applied to claim 25 above, and further in view of Kolls(US 2001/0016819A1).

Drummond et al. fail to teach smart-card processing unit reads e-commerce information stored on microchip and third type viewed on display is e-commerce information read by smart card processing unit. However, Kolls does teach smart-card processing unit reads e-commerce information stored on microchip and third type viewed on display is e-commerce information read by smart card processing unit(Abstract, para 0121, 0173). Therefore, it would have been obvious to one of ordinary skill in the art the time the Applicant's invention was made to modify the teachings of Kolls to include the step of Drummond et al. The motivation to combine these references is to facilitate e-commerce using smart cards.

Other references for the inventor's review that were not used, but deal with the same topic include:

Host and User Transaction System, WO 94/10657, Bertina et al.
Card-Shaped Data Carrier and Method for Producing the Same, US 6572021B1, June 3, 2003, Lippert.

Credit/Service Card with Expanded Surface Area, US 5308121A, May 3, 1994, Gunn.

Integrated Circuit Card With Identity Authentication Table and Authorization Tables Defining Access Rights Based on Boolean Expressions of Authenticated Indentites, US 5657915 B1, May 20, 2003, Guthery.

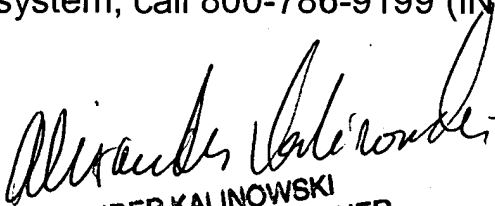
Four-Party Credit/Debit Payment Protocol, US 6327578 B1, December 4, 2001.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Debra F. Charles whose telephone

number is (571) 272 6791. The examiner can normally be reached on 9-5 Monday thru Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexander G. Kalinowski can be reached on (571) 272 6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


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